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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,857	12/01/2003	Donald E. Frail	PC 27833 (01459.US1)	2162
28880	7590	04/19/2006	EXAMINER	
WARNER-LAMBERT COMPANY			GEMBEH, SHIRLEY V	
2800 PLYMOUTH RD			ART UNIT	
ANN ARBOR, MI 48105			PAPER NUMBER	

1614

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/724,857

Applicant(s)

FRAIL ET AL.

Examiner

Shirley V. Gembeh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The response filed January 30, 2006 presents remarks and arguments to the office action mailed July 28, 2005. Applicant's request for reconsideration of the rejection of the claims in the last office action has been considered.

### **Status of Claims**

Claim 1 is amended.

Claim 1-29 are pending in the action.

### **Response to Amendment**

In response to the Office Action dated July 28, 2005, Applicant has provided arguments for the patentability of claims 1-25.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### **Withdrawn Rejections**

The obviousness-type double patenting rejection is withdrawn in view of the abandonment of application 10724856.

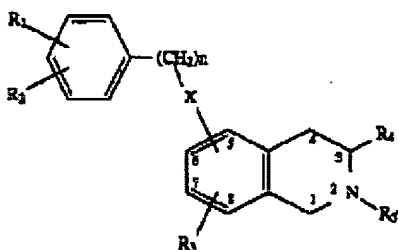
Applicant's arguments, with respect to 35 USC § 112 have been fully considered and are persuasive. The rejection has been withdrawn.

### ***Claim Rejections - 35 USC § 103***

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Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blankley et al., US 5,489,686 taken with Beck et al., US 6,579,885 ('885).

Blankley et al teach treating urinary disorder (see col. 3 lines 20-40) with substituted 1, 2, 3, 4-tetrahydroisoquinolines, a



compound

structurally similar to that of the claimed

invention.

Beck et al teach methods of treatment of various neurological disorders (column 1 lines 7+ and stress disorder (claim 1) (column 14 line 35) administering the compound aryl and heteroaryl substituted tetrahydroisoquinoline column 2 line 52-53. Beck also teaches the moieties/derivatives attached to be effectively the same in claims 2-29, e.g. R<sup>1</sup> through R<sup>8</sup> is the same taught by Beck.

Although, the compounds are not identical, the core structure of the compound taught by Blankley is the same as that of the claimed subject matter. Nothing is obvious in substituting the known claimed compound for the structurally similar compound taught by Beck or as disclosed in the claimed invention, since such structurally related compound suggest one another and would be expected to share common properties.

One of ordinary skill in the art would have been motivated to combine the above cited teachings and employ in the treatment of urinary diseases such as urinary

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incontinence, urinary urge because the prior art teaches treating urinary disease with substituted tetrahydroisoquinoline.

Applicant traverse: that none of the references teach suggest or teach the use of compound of formula I to treat urinary disease.

In response, arguments with respect to claims 1-29 rejected over Beck et al., US 6,579,885 ('885), in view of DeBernardis et al., US 5,389,638 ('638) have been considered but are moot in view of the new ground(s) of rejection. See supra.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembel whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

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